

PATENT COOPERATION TREATY

From the
INTERNATIONAL PRELIMINARY EXAMINING AUTHORITY

2003/0011018-WW
T. INGA Hildreth
ATTY REVIEWED MB
DATE PCT

To:

GILFILLAN, Marie
Darby & Darby P.C.
Post Office Box 5257
New York, NY 10150-5257
ETATS-UNIS D'AMERIQUE

NOTIFICATION OF TRANSMITTAL OF THE INTERNATIONAL PRELIMINARY EXAMINATION REPORT

(PCT Rule 71.1)

Date of mailing
(day/month/year) 18.08.2004

Applicant's or agent's file reference
200M018-WO0

IMPORTANT NOTIFICATION

International application No.
PCT/US 03/28182

International filing date (day/month/year)
10.09.2003

Priority date (day/month/year)
10.09.2002

Applicant
TAKASAGO INTERNATIONAL CORP.

1. The applicant is hereby notified that this International Preliminary Examining Authority transmits herewith the international preliminary examination report and its annexes, if any, established on the international application.
2. A copy of the report and its annexes, if any, is being transmitted to the International Bureau for communication to all the elected Offices.
3. Where required by any of the elected Offices, the International Bureau will prepare an English translation of the report (but not of any annexes) and will transmit such translation to those Offices.
4. **REMINDER**

The applicant must enter the national phase before each elected Office by performing certain acts (filing translations and paying national fees) within 30 months from the priority date (or later in some Offices) (Article 39(1)) (see also the reminder sent by the International Bureau with Form PCT/IB/301).

Where a translation of the international application must be furnished to an elected Office, that translation must contain a translation of any annexes to the international preliminary examination report. It is the applicant's responsibility to prepare and furnish such translation directly to each elected Office concerned.

For further details on the applicable time limits and requirements of the elected Offices, see Volume II of the PCT Applicant's Guide.

The applicant's attention is drawn to Article 33(5), which provides that the criteria of novelty, inventive step and industrial applicability described in Article 33(2) to (4) merely serve the purposes of international preliminary examination and that "any Contracting State may apply additional or different criteria for the purposes of deciding whether, in that State, the claimed inventions is patentable or not" (see also Article 27(5)). Such additional criteria may relate, for example, to exemptions from patentability, requirements for enabling disclosure, clarity and support for the claims.

Name and mailing address of the international
preliminary examining authority:



European Patent Office
D-80298 Munich
Tel. +49 89 2399 - 0 Tx: 523656 epmu d
Fax: +49 89 2399 - 4465

Authorized Officer



Gallego, A

Tel. +49 89 2399-8102



INTERNATIONAL PRELIMINARY EXAMINATION REPORT

(PCT Article 36 and Rule 70)

Applicant's or agent's file reference 200M018-WO0		FOR FURTHER ACTION See Notification of Transmittal of International Preliminary Examination Report (Form PCT/PEA/416)	
International application No. PCT/US 03/28182	International filing date (day/month/year) 10.09.2003	Priority date (day/month/year) 10.09.2002	
International Patent Classification (IPC) or both national classification and IPC A61K7/46			
Applicant TAKASAGO INTERNATIONAL CORP.			
<p>1. This international preliminary examination report has been prepared by this International Preliminary Examining Authority and is transmitted to the applicant according to Article 36.</p> <p>2. This REPORT consists of a total of 5 sheets, including this cover sheet.</p> <p><input checked="" type="checkbox"/> This report is also accompanied by ANNEXES, i.e. sheets of the description, claims and/or drawings which have been amended and are the basis for this report and/or sheets containing rectifications made before this Authority (see Rule 70.16 and Section 607 of the Administrative Instructions under the PCT).</p> <p>These annexes consist of a total of 2 sheets.</p>			
<p>3. This report contains indications relating to the following items:</p> <p>I <input checked="" type="checkbox"/> Basis of the opinion</p> <p>II <input type="checkbox"/> Priority</p> <p>III <input type="checkbox"/> Non-establishment of opinion with regard to novelty, inventive step and industrial applicability</p> <p>IV <input checked="" type="checkbox"/> Lack of unity of invention</p> <p>V <input checked="" type="checkbox"/> Reasoned statement under Rule 66.2(a)(ii) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement</p> <p>VI <input type="checkbox"/> Certain documents cited</p> <p>VII <input type="checkbox"/> Certain defects in the international application</p> <p>VIII <input type="checkbox"/> Certain observations on the international application</p>			
Date of submission of the demand 07.04.2004		Date of completion of this report 18.08.2004	
Name and mailing address of the international preliminary examining authority:  European Patent Office D-80298 Munich Tel. +49 89 2399 - 0 Tx: 523656 epmu d Fax: +49 89 2399 - 4465		Authorized Officer Vayssié, S Telephone No. +49 89 2399-8635 	

**INTERNATIONAL PRELIMINARY
EXAMINATION REPORT**

International application No. **PCT/US 03/28182**

I. Basis of the report

1. With regard to the **elements** of the international application (*Replacement sheets which have been furnished to the receiving Office in response to an invitation under Article 14 are referred to in this report as "originally filed" and are not annexed to this report since they do not contain amendments (Rules 70.16 and 70.17)*):

Description, Pages

1-33 as originally filed

Claims, Numbers

1-11 filed with telefax on 18.06.2004

2. With regard to the **language**, all the elements marked above were available or furnished to this Authority in the language in which the international application was filed, unless otherwise indicated under this item.

These elements were available or furnished to this Authority in the following language: , which is:

- ☐ the language of a translation furnished for the purposes of the international search (under Rule 23.1(b)).
- ☐ the language of publication of the international application (under Rule 48.3(b)).
- ☐ the language of a translation furnished for the purposes of international preliminary examination (under Rule 55.2 and/or 55.3).

3. With regard to any **nucleotide and/or amino acid sequence** disclosed in the international application, the international preliminary examination was carried out on the basis of the sequence listing:

- ☐ contained in the international application in written form.
- ☐ filed together with the international application in computer readable form.
- ☐ furnished subsequently to this Authority in written form.
- ☐ furnished subsequently to this Authority in computer readable form.
- ☐ The statement that the subsequently furnished written sequence listing does not go beyond the disclosure in the international application as filed has been furnished.
- ☐ The statement that the information recorded in computer readable form is identical to the written sequence listing has been furnished.

4. The amendments have resulted in the cancellation of:

- ☐ the description, pages:
- ☒ the claims, Nos.: 12-26
- ☐ the drawings, sheets:

5. ☒ This report has been established as if (some of) the amendments had not been made, since they have been considered to go beyond the disclosure as filed (Rule 70.2(c)).

(Any replacement sheet containing such amendments must be referred to under item 1 and annexed to this report.)

see separate sheet

6. Additional observations, if necessary:

**INTERNATIONAL PRELIMINARY
EXAMINATION REPORT**

International application No. PCT/US 03/28182

IV. Lack of unity of invention

1. In response to the invitation to restrict or pay additional fees, the applicant has:

- ☒ restricted the claims.
- ☐ paid additional fees.
- ☐ paid additional fees under protest.
- ☐ neither restricted nor paid additional fees.

2. ☐ This Authority found that the requirement of unity of invention is not complied with and chose, according to Rule 68.1, not to invite the applicant to restrict or pay additional fees.

3. This Authority considers that the requirement of unity of invention in accordance with Rules 13.1, 13.2 and 13.3 is

- ☒ complied with.
- ☐ not complied with for the following reasons:

4. Consequently, the following parts of the international application were the subject of international preliminary examination in establishing this report:

- ☒ all parts.
- ☐ the parts relating to claims Nos. .

V. Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement

1. Statement

Novelty (N)	Yes: Claims	1-11
	No: Claims	
Inventive step (IS)	Yes: Claims	1-11
	No: Claims	
Industrial applicability (IA)	Yes: Claims	1-11
	No: Claims	

2. Citations and explanations

see separate sheet

Section I

Amendments to the examined application, as received on 18.06.04, do **not** fulfill the requirements of Article 34(2)b) PCT and are therefore **not** admissible, for the following reasons:

- Claim 4: Applicant indicates original Claims 8-11 as basis for this new claim. This new claim, however, is dependent on Claim 1, corresponding to invention identified as 1 in the International Search Report, whereas original Claims 8-11 were dependent on original claim 8, corresponding to invention 2. Therefore, a combination of features belonging to two distinct compositions/inventions is made, which was not disclosed originally.

Section V

a) Documents of the State of the Art

Reference is made to the following documents:

- D1: WO 02/062311 A (GIRBOUX ANNE-LISE ;MARTEAUX LEON ANDRE (BE); DOW CORNING SA (BE);) 15 August 2002 (2002-08-15)
- D2: EP-A-0 874 017 (DOW CORNING SA) 28 October 1998 (1998-10-28)
- D3: WO 01/58986 A (GIRBOUX ANNE LISE ;MARTEAUX LEON ANDRE (BE); DOW CORNING SA (BE)) 16 August 2001 (2001-08-16)
- D4: US 2002/034490 A1 (MURRAY ANDREW MALCOLM ET AL) 21 March 2002 (2002-03-21)

b) Industrial Applicability

All claims fulfill the requirements of Article 33(4) PCT.

c) Novelty and Inventive Step

Although D1 (combined with D2 internally referred to) and D3 both disclose compositions containing a fragrance and a S/W-emulsion comprising a surfactant, wherein the silicone has a viscosity of 100 millions mm²/s or more and a particle size of 2 microns or less (subject-matter as originally claimed), see D1, page 7, line 31-32; paragraph 26, claim 1; D3, page 11, line 2-6, 16, 18-20, claim 1, the International Examining Authority considers that the now claimed subject matter, defining more precisely the fragrance composition, can be considered as novel and inventive over

the available prior art.

Indeed, both D1 and D3 fail to disclose the fragrance composition as now claimed in Claim 1. It is the unique merit of the Applicant to have discovered that, when using this specific fragrance composition in combination with the specific, claimed silicone emulsion, better deposition of the fragrance can be achieved (application, page 2, lines 1-6).

Section VIII

The application does not meet the requirements of Article 6 PCT for the following reasons:

- The subject-matter of Claim 1 is not clear, because the temperature for the viscosity measure has not been specified (see page 10, line 1 from the description). This claim is therefore not self-contained as required by Article 6 PCT in view of the PCT-Guidelines PCT/GL/3 III, 4.2.
- It is clear from the description on page 23 that the feature "for skin care" is essential to the definition of the invention. Since independent Claim 1 does not contain this feature, it does not meet the requirement following from Article 6 PCT taken in combination with Rule 6.3(b) PCT that any independent claim must contain all the technical features essential to the definition of the invention.